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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/617,593	07/18/2000	Reto Stamm	X-677 US	9386

7590

07/21/2005

Edel M Young  
Xilinx Inc  
2100 Logic Drive  
San Jose, CA 95124

EXAMINER

PARK, CHAN S

ART UNIT PAPER NUMBER

2622

DATE MAILED: 07/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 09/617,593	<b>Applicant(s)</b> STAMM ET AL.	
	<b>Examiner</b> CHAN S. PARK	<b>Art Unit</b> 2622	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 01 July 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ They raise the issue of new matter (see NOTE below);  
 (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
 The status of the claim(s) is (or will be) as follows:  
 Claim(s) allowed: \_\_\_\_\_.  
 Claim(s) objected to: \_\_\_\_\_.  
 Claim(s) rejected: 1-5, 7-16 and 18-21.  
 Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.  
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s): \_\_\_\_\_.  
 13. ☐ Other: \_\_\_\_\_.

  
**EDWARD COLES**  
 SUPERVISORY PATENT EXAMINER

## DETAILED ACTION

### *Advisory Action*

1. The period for reply continues to run 6 MONTHS from the date of the final rejection. Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a) accompanied by the appropriate fee. The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. A reply within the meaning of 37 CFR 1.113 or a request for a continued examination (RCE) in compliance with 37 CFR 1.114 must be timely filed to avoid abandonment of this application.

### *Response to Amendment*

2. The amendment filed 7/1/05 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because:

- a. Applicant's argument filed 7/1/05 have been fully considered but they are not persuasive.

Regarding **claims 12-15 and 18-20**, the applicant explains how the current invention is different from the teachings of Mucciolo. Particularly, the applicant states that Mucciolo fails to disclose a reformatting mechanism configured to reformat a presentation as a miniature presentation having the size of a business card as recited in claim 12. Examiner respectfully disagrees. The size of the presentation material of

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Mucciolo can be resized/reformatted according to the user's preference. Further, since the size can be set to 2 x 3½, reformatting of the presentation material as a miniature presentation having the size of a business card is performed according to the teaching of Mucciolo. Thus, examiner believes that Mucciolo has a complete detail "as is contained in the ... claim."

Furthermore, the applicant quotes MPEP 2131.03 which states:

If the claims are directed to a narrow range, the reference teaches a broad range, and there is evidence of unexpected results within the claimed narrow range, depending on the other facts of the case, it may be reasonable to conclude that the narrow range is not disclosed with "sufficient specificity" to constitute an anticipation of the claims. The unexpected results may also render the claims unobvious.

The applicant states that reformatting the presentation as a miniature presentation has particular unexpected benefits and results. The invention might have a different intention/benefit for reformatting the presentation material as a miniature presentation. However, examiner does not find any unexpected results in the invention that is not disclosed in the teachings of Mucciolo. It is respectfully noted that both the invention and Mucciolo have the expected results. That is, when reformatting of the presentation material to a smaller size is instructed, creating a smaller presentation material is performed as expected. It is unclear as to exactly what unexpected results the applicant is relying on.

Therefore, the rejection of **claims 12-15 and 18-20** is maintained.

Regarding **claims 1-3, 5, 7 and 11**, the applicant explains how the current invention is different from the teachings of Mucciolo and Skarbo. Particularly, the

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applicant states that a Banner, letter paper, and A4 paper of Mucciolo are not "a miniature printed version". Examiner respectfully disagrees. As is well-known, Powerpoint of Mucciolo has the capability of reducing a plurality of the presentation materials in the size of either a Banner, letter paper, or A4 paper size ('Handouts' function in page 180). That is, the plurality of the images/presentation materials is reduced to fit in one sheet.

Furthermore, examiner notes that the term "a miniature printed version of the presentation materials" can be interpreted in many different ways. Since the size of the original presentation materials is not clearly defined, letter paper and A4 paper can be interpreted as the "miniature" version of the presentation materials. Should the applicant disagree, examiner respectfully requests the applicant to provide support for his assertion that the presentation material must be smaller than the size of banner, letter paper, and A4 paper.

Furthermore, the applicant states that the marketing product and the miniature printed version are separate elements. However, it is noted that the features upon which applicant relies are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, the term "marketing product" is not clearly defined in the claims to distinguish the differences between the invention and Mucciolo.

Furthermore, the applicant states that "it would be impossible to distribute such physical materials in the personal computer conference described in Skarbo." Examiner

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disagrees with this assertion since Mucciolo, the same field of endeavor of the presentation art, teaches the method of printing out the presentation materials so that the audiences do not have to physically write down all the information presented during the presentation. By combining the two references the audiences no longer have to write down the various information, such as name, company name, job title, and etc., on the BizCard.

Finally, as set forth above, Mucciolo, not Skarbo, teaches the step of creating a miniature printed version of the presentation materials in the size of a marketing product.

Therefore, for at least these reasons, Examiner believes **claims 1-3, 5, 7 and 11** are not allowable and the previous rejection should be maintained.

Regarding **claim 21**, the applicant explains how the current invention is different from the teachings of Stephan and Mucciolo. Particularly, the applicant states, “[n]owhere does Stephan mention or disclose that the long distance calling information is a presentation presented by the person on the reverse side of the card.” If this business card, which incorporates the calling card information, is not presented by the person on the first side, who else would give out someone else’s business? It is understood that the second face having a presentation material is presented by the person, not by a third party, corresponding to the identification information on the first face according to the teaching of Stephan.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., all people who view the same presentation would receive the same business card having a miniature version of that presentation printed thereon) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Therefore, for at least these reasons, Examiner believes **claim 21** is not allowable and the previous rejection should be maintained.

### ***Conclusion***

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

csp  
July 15, 2005

Chan S. Park  
Examiner  
Art Unit 2622

  
EDWARD COLES  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800